

**REMARKS**

Claims 2-7 and 9-14 are pending.

Applicants thank the Examiner for courtesies extended during a telephone interview September 10, 2008. During the interview, the Examiner admitted that he had not considered certain claim limitations and asked applicants to file a response with remarks directed to these limitations. The Examiner also indicated that Ishikawa does disclose that a document can be in black and white (monochrome), and that the claim recites color *or* monochrome. However, as noted below, although Ishikawa does disclose monochrome data, the size of the block of data to be compressed is not dependent on whether the data is monochrome or color.

Claims 2-6 and 9-13 stand rejected under 35 USC 102(e) as being anticipated by Ishikawa, U.S. Patent No. 5,838,833. This rejection is respectfully traversed.

Claim 5 recites "a controller which sets a size of the block of the data to be compressed by said compressor depending on an attribute of the data, wherein the data attribute is color or monochrome." The Examiner has failed to specifically allege where Ishikawa teaches that the size of the block of the data to be compresses is set depending on whether the data is color or monochrome. Although Ishikawa does disclose that a document to be compressed can be in monochrome, Ishikawa does not actually disclose that any decision is made as to the size of the block to be compressed depending on whether the data is monochrome. Merely because Ishikawa discloses that a document can be monochrome does not meet all of the limitations of claim 5. Ishikawa fails to teach or suggest the features of claim 5.

Claim 6 recites "a controller which sets a size of the block of the data to be compressed by said compressor depending on an attribute of the data, wherein the attribute of the data is binary data or multi-valued data." As noted above with respect to claim 5, the Examiner has not specifically set forth the disclosure in Ishikawa which he believes teaches this feature of claim 6. For the reasons set forth above, applicants maintain that Ishikawa does not teach a controller which

sets a size of the block of the data to be compressed depending on whether the data is binary or multi-valued data. Thus, Ishikawa fails to teach or suggest the features of claim 6.

The remaining claims are allowable at least due to their dependencies on claims 5 and 6. Applicants request that this rejection be withdrawn.

Claims 7 and 14 stand rejected under 35 USC 103(a) as being unpatentable over Ishikawa in view of Barnsley, U.S. Patent No. 5,065,447. This rejection is respectfully traversed.

Claim 7 recites "a controller which sets a size of the block of the data to be compressed by said compressor depending on an attribute of the data, wherein the attribute of the data is a FAX/copy job or another job other than the FAX/copy job." Ishikawa and Barnsley, either alone or in combination, fail to teach or suggest the features of claim 7.

The Examiner admits that Ishikawa fails to disclose wherein the attribute of the data is a FAX/copy job or another job other than a FAX/copy job, but asserts that this feature is taught by Barnsley (citing col. 2, ll. 51-58). Applicants respectfully disagree.

The portion of Barnsley cited by the Examiner is merely a background discussion of the need for effective compression. Barnsley specifically notes that fax transmission could benefit from better compression. This does not relate in any way to setting a compression block based on whether a job is a fax or copy job. Merely because the need to compress fax jobs is known is irrelevant to whether it would have been obvious to have modified Ishikawa to set the size of the compression block based on whether the job was a fax/copy job or not. Thus, applicants submit that Barnsley fails to teach or suggest that which the Examiner asserts and fails to overcome the deficiencies of Ishikawa.

The remaining claims are allowable at least due to their respective dependencies. Applicants request that this rejection be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 325772034800.

Dated: September 25, 2008

Respectfully submitted,

By 

Deborah S. Gladstein

Registration No.: 43,636  
MORRISON & FOERSTER LLP  
1650 Tysons Blvd, Suite 400  
McLean, Virginia 22102  
(703) 760-7753